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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,539	11/10/2003	James P. Miarka	ITT-518-A	5134

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EXAMINER

CHAN, KO HUNG

ART UNIT PAPER NUMBER

3632

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/705,539

Applicant(s)

MIARKA ET AL.

Examiner

Korie H. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/10/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/02/003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, drawn to a clip apparatus, classified in class 248, subclass 68.1.
- II. Claims 12-20, drawn to method of making clip apparatus, classified in class 264, subclass 34.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different product such as a vibration dampening pallet with a grip for securing article thereon.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with William Hanlon Jr. on August 17, 2005 a provisional election was made with traverse to prosecute the invention of group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office

action. Claims 12-20 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5, it is not clear whether "a support mount" on line 3, is the same element as "a mount" of claim 1, last line. Further, the following lack proper antecedent basis: "the sidewalls" on line 4 of claim 5, "the center portion" on line 6 of claim 5, "the two side legs" on line 3 of claim 6, and "the side wall center" on lines 2-3 of claim 8. Claim 7, "one side wall" is vague as it is not clear one side wall of what element.

***Claim Rejections - 35 USC § 102***

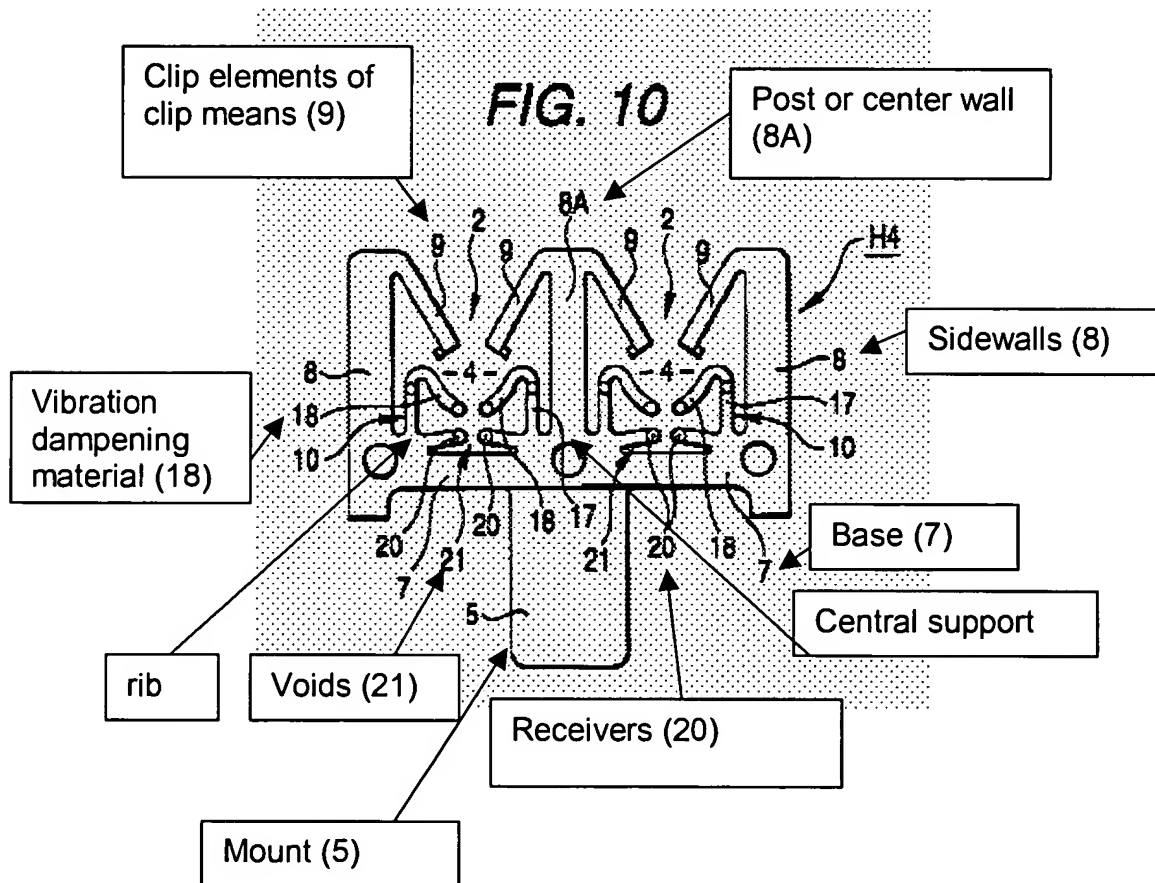
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohnuki (US patent no. 6,371,419). Ohnuki discloses all the claimed features of applicant's invention as illustrated below.



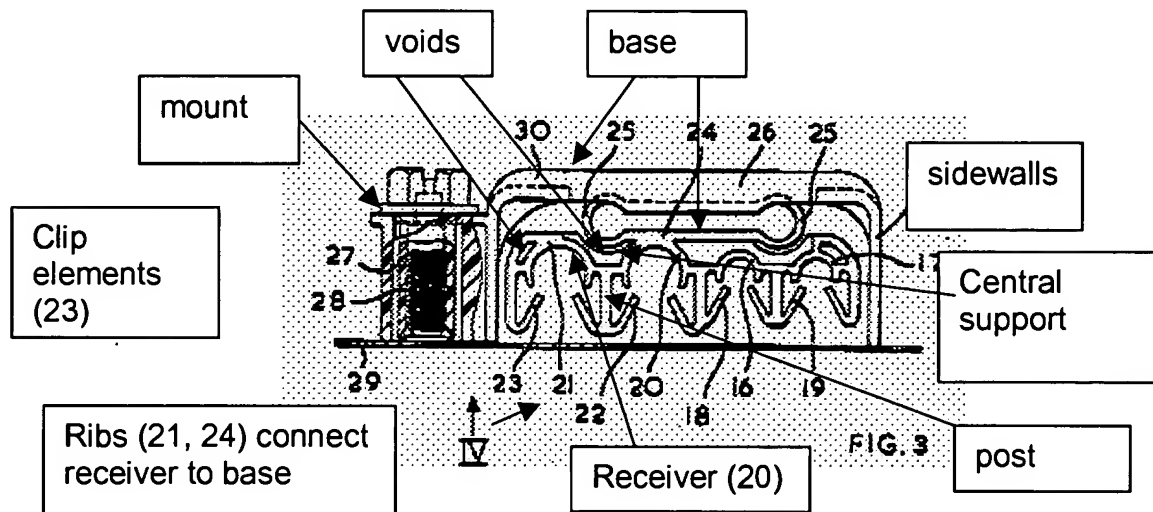
### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schliessner (US patent no. 5,588,683) in view of Shereyk et al (US patent no. 6,926,237). Schliessner discloses all the claimed features of applicant's invention as illustrated below:



However, Schliessner does not show vibration dampening material in a portion of the receiver. Shereyk teaches a vibration damping clip having receivers (30, figure 2) with vibration dampening material (16) molded in a over-molding process (Col. 4, lines 45-49) within the receivers and the dampening material is disposed about or located on either side of the center portion (30). Such vibration dampening material has the advantage of absorbing energy to dampen vibration or noise transmitted between the item(s) held by the clip (col. 4, lines 31-34). It would have been obvious to one of ordinarily skilled in the art to have modify Schliessner's clip by providing a vibration

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dampening material in the receiver to dampen vibration or noise transmitted between the item(s) held by the clip as taught to be desirable by Shereyk.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schliessner (US patent no. 5,588,683) in view of Shereyk et al (US patent no. 6,926,237) as applied to claim 1 above, and further in view of Tanaka et al (US patent no. 5,153,052). Schliessner and Shereyk combined disclosed all the claimed features of applicant's invention except for disclosing the unitary piece is double-shot molded assembly. Double-shot molding is old and well-known in the art as demonstrated by Tanaka et al. It would have been obvious to one ordinary skill in the art to have substituted the over-flow molding process of Schliessner and Shereyk combined with the double-shot molding process of Tanaka. Such modification would have involved a mere substitution of one well-known molding method with another.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schliessner (US patent no. 5,588,683) in view of Shereyk et al (US patent no. 6,926,237) as applied to claim 1 above, and further in view of Colley (US patent 5,769,556). Schliessner and Shereyk combined disclosed all the claimed features of applicant's invention except for surface irregularities formed in the vibration damper facing the article inserted in the body. Colley teaches in clamp of providing protective material (27, 29) with surface irregularities formed in the protective material facing the article inserted in the body to aid in holding the tubes securely in the their clamped positions (Col. 2, lines 47-49). It would have been obvious to one of ordinarily skilled in the art to have modify the damper of Schliessner and Shereyk combined by providing

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surface irregularities formed in the vibration damper facing the article inserted in the body to aid in holding the tubes securely in the their clamped positions as taught to be desirable by Colley.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The remaining cited art of record demonstrate various clip apparatus with clip elements at an acute angle with the sidewalls.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Korie H. Chan whose telephone number is 571-272-6816. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Korie H. Chan  
Primary Examiner  
Art Unit 3632

khc  
August 17, 2005